

## **REMARKS**

### **Status of Claims**

Claims 2, 7-9, and 17-19 are pending. No amendments to the claims are made herein.

### **Claims rejected under 35 U.S.C. §102**

Claims 2, 7-9 and 17-19 have been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Reeves et al. (U.S. Patent No. 6,759,536, October 2, 1998) (“the ’536 Patent”). The Office alleges that the ’536 Patent discloses every element of the present invention. Applicants respectfully traverse this rejection for the reasons set forth below.

The legal standard for anticipation under 35 U.S.C. § 102 is one of strict identity. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). To anticipate a claim, a single prior source must contain each and every limitation of the claimed invention. *In re Paulson*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) (citing *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990)). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

The Office alleges that the ’536 patent teaches fkbS from the organism *Streptomyces* and takes the position that this disclosure anticipates element (b) of claim 2 drawn to a recombinant gene selected from the group consisting of a crotonyl CoA reductase (*ccr*) from *Streptomyces cinnamonensis*, a *ccr* from *Streptomyces collinus*, a *ccr* from *Streptomyces fradiae*, an isobutyryl CoA mutase (*icm*) from *Streptomyces cinnamonensis*, and a combination thereof.

The fkbS gene from the ’536 patent is from *Streptomyces hygroscopicus* var. *ascomyceticus* (ATCC 14891), which is not one of the organisms named in element (b) of claim 2. In the ’536 patent, fkbS is described as a member of the FK-520 PKS gene cluster. See column 7, lines 48-57. The ’536 patent further disclosed that the FK-520 PKS genes were isolated from *Stepromyces hygroscopicus* var. *ascomyceticus* (ATCC 14891). See column 17, lines 58-64.

Additionally, a reference from Christopher Reeves, one of the inventors on the '536 patent, is attached that more clearly describes how the fkbS gene was isolated from *Streptomyces hygroscopicus* var. *ascomyces* (ATCC 14891). See Exhibit A, section 2.2 on page 82, Table 1 on page 84, and section 3.5 on page 86.

For the reasons presented above, Applicants believe that each and every limitation of the claimed invention, as disclosed in claim 2, is not found in the '536 Patent. Claims 7-9 and 17-19 depend from claim 2. Accordingly, it is respectfully submitted that the strict identity standard of anticipation under 35 U.S.C. § 102(e) is not met and therefore the rejection of claims 2, 7-9, and 17-19 may properly be withdrawn.

**CONCLUSION**

In view of the foregoing amendment remarks, Applicants respectfully aver that the Examiner can properly withdraw the rejection of the pending claims under 35 U.S.C. § 102. Applicants respectfully submit that all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance is respectfully requested.

Applicants respectfully request a telephone conference with the Examiner to expedite prosecution of this application. After the Examiner has reviewed the instant amendment, Applicants request that the Examiner please telephone the undersigned at (858) 720-7987.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing Attorney Docket No. 300622004810. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 11, 2009

Respectfully submitted,

By: /Daniel A. Rubé/

Daniel A. Rubé

Registration No.: 53,536

MORRISON & FOERSTER LLP

12531 High Bluff Drive, Suite 100

San Diego, California 92130-2040

(858) 720-7987